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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/025,345	02/18/1998	JERALD C. HINSHAW	2507-5818.1US(21494-US-09	9478

7590 05/20/2004

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/025,345

Applicant(s)

HINSHAW ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84, 85 and 87-117 is/are pending in the application.
- 4a) Of the above claim(s) 92-101, 103-113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The reply filed on January 20, 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

In the reply, applicants failed to address several issues under 35 USC 112, 2nd paragraph. One such issue involves the meaning of the claim terms as noted in Paper No. 37, paragraph 5, e.g., “formulated for generating gas suitable for use in deploying an air bag or balloon from a supplemental restraint system,” (emphasis added) and similar language in other claims, as set forth in paragraph 5 of Paper No. 37, mailed October 16, 2003. Therein, it was noted that, in reply to a rejection in Paper No. 14, applicants stated that the noted claim terminology had a certain meaning. Any such statement is made in accordance with applicants’ duty of candor, and the Office has a right to rely thereon, and the Examiner did so rely. Later, applicants stated in their Appeal Brief, that this terminology had a different meaning, which the Office has a right to reply on, and which the Honorable Board of Patent Appeals and Interferences panel did rely on, in deciding the Appeal herein. However, these meanings, both stated by applicants, appear inconsistent. Applicants have not addressed the issue: The doctrine of file wrapper exists, and the Office and the public have a right to rely on applicants’ statements as to the meaning of claim terms. Case law shows applicants’ arguments affect the meaning of claim terms. See, one example of many, *Lemelson Medical, Education & Research Foundation LP v. Intel Corp.*, 61 USPQ2d 1905 (DC Ariz 2002), wherein one finds:

“Prosecution history of patent for method of manufacturing electrical devices on substrate does not warrant finding that “semi-conducting material” of asserted claim is limited to compounds, since nothing in inventor’s arguments to patent examiner indicates that inventor intended claim phrase “semi-conducting material such as compounds of germanium, silicon, tantalum and others” to limit claimed material to compounds....”

Thus, where file wrapper estoppel exists as to two different meanings for the identical claim term, how can the claim terms be understood and definite under 35 USC 112, 2nd paragraph? This does not relate to some meaning from the specification; instead, it goes to different and apparently inconsistent meanings, each equally applicable, under file wrapper estoppel. Applicants' reply referring to the specification for meaning does not address this issue.

2. Further, applicants failed to reply to the indefiniteness rejection as to "suitable" in that the examiner pointed out approximately 14 different references in the prior art teaching apparatus and/or compositions suitable for use therein, and as to which applicants have not commented, including as to the issue that gas generating apparatus spans a broad spectrum of apparatus, for which requirements differ, depending on apparatus specifics, while the instant claims have been left broad as to the kind of apparatus. What might have been the case in a different proceeding, is irrelevant to a proceeding in which the record differs, so such an argument is not responsive to the rejection. Since, during prosecution, the "broadest reasonable interpretation" should be used, and the prior art provides many such broad, reasonable interpretations for various suitable apparatus, *c.f.*, *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997), applicants' failure to discuss the relevant and applied prior art for what the terms mean, *e.g.*, the definiteness or indefiniteness thereof, constitutes a failure to properly respond. Further, the failure to reply regarding the cited references, leaves an impression of inoperability of the cited references, which is impermissible, as set forth in Paper No. 37. Applicants have failed to discuss this issue. Applicants also failed to discuss the cited case law about the scope of "comprising", in this rejection for indefiniteness.

3. Applicants did not respond as to the correct Wardle et al. reference, which is US Pat. No. 5,472,534, not as urged by applicants in the reply. The electronic record appears to lack one form 1449, of the three mentioned in Paper No. 32. It is believed that this patent may have been cited in

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the missing form 1449. Since Paper No. 4, filed December 18, 1998, with 12 pages of references is of record, applicant is requested to supply duplicates of the other form 1449's. The remaining one in the record was received April 10, 1998, although the Paper No. was obscured in the scan process. Please supply in your reply, a copy of the IDS pages which were returned to applicants in Paper No. 32, as to the missing IDS form 1449. In case Wardle et al. USP 5,472,534 is not otherwise of record, note attached form 892, Notice of References cited.

4. In the reply to the obviousness type double patenting rejection, applicants refer to "terminal disclaimers." However, in the official electronic record, only one such disclaimer is found, for USP 5,673,935. Thus, the record contains no terminal disclaimer for 6,039,820, and the reply is non-responsive for this reason. The examiner does not know if applicants failed to include it, or if the contractors who scanned the submitted documents failed in the scanning process. In any event, the official record does not reflect the second terminal disclaimer.

5. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

6. See 37 CFR 1.111(b) and 37 CFR 1.135:

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

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§ 1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

7. Note also from 714.03, in pertinent part:

Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward A. Miller whose telephone number is (703) 306-4163. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miller/em
May 14, 2004


EDWARD A. MILLER
PRIMARY EXAMINER